

THIS DISPOSITION IS
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OF THE TTAB

Mailed: July 12, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Brainworks, Inc.

v.

Brainworks LLC

Opposition No. 91150456
to application Serial No. 76144650
filed on October 10, 2000

Gerald G. Crutsinger of Crutsinger & Booth for Brainworks,
Inc.

Ken J. Pedersen of Pedersen & Company, PLLC for Brainworks
LLC.

Before Simms, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Brainworks LLC (hereinafter applicant) has filed an
application to register on the Principal Register the mark
BRAINWORKS for services amended to read: "therapy and
rehabilitation services, namely, biofeedback and
neurofeedback services" in International Class 42. The
application is based on applicant's assertion of a bona fide

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intention to use the mark in commerce in connection with the identified services.

Brainworks, Inc. (hereinafter opposer) filed a notice of opposition, alleging as grounds therefor that it "operates an educational, testing and consulting business in Carrollton, Texas"; that since at least April 27, 1981, opposer has used the mark BRAINWORKS in connection with certain of its services and that it continues to use the mark; that it owns Registration No. 1,303,169 for "educational services, namely, conducting seminars for educational institutions and teachers in the field of developing thinking skills" in International Class 41 and "educational testing and consulting services" in International Class 42,¹ Registration No. 1,404,918 for "educational activity kits comprising printed teaching material concerning learning skills and games, toys and playthings" in International Class 16,² Registration No. 2,099,126 for "retail and wholesale store services in the field of educational materials; and retail, wholesale and mail order services featuring educational materials in a wide variety of fields advertized in catalogs, workshops, trade shows and on the Worldwide Web" in International Class 35 and "production and publication of books, periodic

¹ Registration No. 1,303,169, issued October 30, 1984; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

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newsletters, posters, slides, video and audio presentations, instruction manuals, student workbooks, activity books, printed materials for conducting conferences, seminars and workshops" in International Class 41,³ and Registration No. 2,451,130 for "computer software for use in teaching various educational subjects to improve academic performance, learning skills and thinking skills used in the field of education and user manuals packaged as a unit" in International Class 9,⁴ all for the mark BRAINWORKS; and that applicant's mark, when used in connection with its services, so resembles opposer's previously used and registered mark BRAINWORKS, as to be likely to cause confusion, mistake, or deception in contravention of Section 2(d) of the Trademark Act.

In its answer applicant denies the salient allegations of the notice of opposition.

Both parties filed briefs on the case, and neither party requested an oral hearing.

The record consists of the pleadings; the file of the opposed application; opposer's notice of reliance filed May 15, 2003 (Item Nos. 1-40); and applicant's notice of

² Registration No. 1,404,918, issued August 12, 1986; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

³ Registration No. 2,099,126, issued September 23, 1997; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

⁴ Registration No. 2,451,130, issued May 15, 2001.

reliance filed July 9, 2003 (Item Nos. 1-2). Neither party took the testimony of any witnesses.

Preliminary Matters

Applicant filed (on June 13, 2003, via a certificate of mailing) a motion to strike Item Nos. 4-9, 19 and 28-40 in opposer's notice of reliance; and in its reply brief on the motion, applicant requested that opposer's untimely supplemental notice of reliance be disregarded. In addition, on December 17, 2003 (via certificate of mailing), applicant filed a motion to strike portions of opposer's reply brief on the case.

On November 26, 2003 the Board issued an order in which (i) opposer's supplemental notice of reliance was stricken as untimely, (ii) applicant's motion to strike was granted as to Item Nos. 4-9,⁵ 19, 28-31, 33, 34 and 36-38, and (iii) the motion was deferred until final decision with regard to the remaining items. In a Board order dated March 23, 2004, applicant's motion to strike portions of opposer's reply brief on the case was deferred until final decision.

⁵ The interlocutory Board order striking Item No. 9 (opposer's combined first set of interrogatories and document requests to applicant) is hereby overruled. The interrogatories were appropriate, and in fact, required by Trademark Rule 2.120(j)(3)(i) because opposer was relying on applicant's answers thereto. Informationally, the parties' attorneys are advised that generally documents produced by the adverse party are not admissible by way of a notice of reliance as set forth in Trademark Rule 2.120(j)(3)(ii). However, it is clear that the parties stipulated this material into the record. Thus, Item No. 9 is admissible in its entirety.

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With regard to the remaining items in opposer's notice of reliance -- Item Nos. 32 (Merriam-Webster's Collegiate

Dictionary definition of the word "biofeedback"), 35 (the file history of the opposed application), 39 and 40 (two paperback books published by opposer) -- the Board hereby denies applicant's motion to strike these items. The dictionary definition is admissible pursuant to Trademark Rule 2.122(e); the application file forms part of the record pursuant to Trademark Rule 2.122(b) without any action taken by the parties;⁶ and the two paperback books would be in general circulation among "that segment of the public which is relevant" under Trademark Rule 2.122(e).⁷

We also note that normally the materials submitted in support of and in opposition to a previously denied motion for summary judgment are not part of the record unless properly made so at trial. However, in this case, opposer included such papers in its notice of reliance (Item Nos. 13, 14 and 16), and applicant did not object thereto, thus stipulating the materials into the record.⁸

⁶ Several of the non-objected to items in opposer's notice of reliance (e.g., the notice of opposition and applicant's answer thereto, and Board orders issued in the case) are also of record without any need for a notice of reliance thereon.

⁷ The better practice for opposer would have been to include a statement of the relevance of the two publications in its notice of reliance. See Trademark Rule 2.122(e). In any event, the two publications are admissible only for what they show on their face, not for the truth of the matters asserted therein because no competent witness testified to the truth of such matters. See *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, footnote 5 (TTAB 1989), *aff'd* 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990).

⁸ Applicant's statement (brief, footnote 6) that motion papers are "pleadings" is incorrect. See Trademark Rules 2.104(a),

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Turning then to applicant's motion to strike (i) certain of the documents attached to opposer's reply brief (Document Nos. 3-9 and 12), and (ii) a certain portion of the reply brief itself which assertedly raises a new issue (whether applicant's identification of services complies with TMEP §1402), the Board grants applicant's motion to strike certain documents attached thereto and those documents have been given no consideration.

Regarding striking a portion of the reply brief itself, the Board does not generally strike a properly and timely filed brief, or portions thereof. However, any objections the adverse party has to the contents of the brief itself will be considered by the Board in its consideration of the case, and any improper portions of any brief will be disregarded. See TBMP §539 (2d ed. rev. 1, March 2004).

As a final preliminary matter applicant argued in its brief that "opposer does not possess a relevant common law mark" noting that "opposer has not pled or explicitly claimed a common law right to the mark [BRAINWORKS] in connection with rehabilitation services or biofeedback services" and that "any implicit claim to a common law mark must fail." (Applicant's brief, p. 9.) Opposer did not respond to this argument. Applicant is correct that opposer neither pled nor tried any claim of common law rights in the

2.106(b) (1), 2.107 and 2.116(c). See also, Fed. R. Civ. P. 7(a)

mark BRAINWORKS. Thus, common law rights will not be further addressed herein.

Parties

Inasmuch as opposer's notice of reliance Item No. 19 (printouts of the pages of opposer's website) was properly stricken by the earlier Board order, there is little information of record regarding opposer's business other than the copies of its pleaded registrations (Item Nos. 20, 22, 24 and 26).⁹

The record shows that opposer, Brainworks, Inc., is a Texas corporation located in Carrollton, Texas. In addition to the four registrations, the record also shows that opposer has published two paperback books, Thinking Smarter: Skills for Academic Success by Carla Crutsinger and ADD Quick Tips: Practical Ways to Manage Attention Deficit Disorder Successfully by Carla Crutsinger and Debra Moore.

The information of record regarding applicant comes from applicant's application file, and from applicant's answers to opposer's first set of interrogatories and document requests (made of record by opposer). Applicant, Brainworks LLC, is a Montana limited liability company

and 8.

⁹ Although opposer did not submit proper status and title copies of its pleaded registrations in accordance with Trademark Rule 2.122(d)(2), applicant has clearly acknowledged that opposer is the owner of the registrations and that they are part of the record herein. See, for example, applicant's brief, pp. 3, 4-5, and 8. Thus, opposer's four pleaded registrations are of record.

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located in Helena, Montana with managing member Bernadette Pedersen and member Paul Pedersen. Ms. Bernadette Pedersen "has practiced using biofeedback equipment either under hospital licensure, under supervision of licensed medical and mental professionals, or under individual licensure since 1990" seeing approximately 100 people in the prior three years. (Applicant's answer to opposer's interrogatory No. 37(a)).

In response to opposer's interrogatory No. 34 wherein applicant was asked to "describe symptoms of conditions of patients or clients of Applicant that are expected to benefit from [applicant's services]" applicant listed numerous "Symptoms Addressed and Conditions Treated," including the following: muscle tension headache; migraine headache; anxiety disorders; panic disorder; ADD/ADHD and other attentional difficulties; chronic pain; fibromyalgia; thoracic outlet syndrome; cognitive rehabilitation to assist with improved information processing of brain-related processes effected by the diagnosis i.e.[,] improved quality or efficiency of reading, listening, writing, speaking, short-term memory, long-term memory, ease of function and learning after head injury, relational/social interactions with family, friends, co-workers, cognitive flexibility after injury, etc.; and restless leg syndrome. (Applicant also answered opposer's interrogatory No. 35(a)-(d) which

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requested that applicant define and describe the services recited in applicant's application -- "therapy," "rehabilitation," "biofeedback" and "neurofeedback.")

In opposer's interrogatory No. 5(a), opposer asked applicant to identify the date on which applicant first used the mark BRAINWORKS for applicant's services and to identify all documents evidencing such use. In applicant's response thereto, it identified its date of first use as "April 1, 2000," but in identifying documents, it stated that there are "no specific documents." According to applicant, its mark is used on stationery and business cards and it appears in local phone directories; with advertising expenditures of approximately \$250 in each of the years 2001 and 2002. Applicant's sales in each of those years were around \$30,000. The territory in which applicant currently uses its mark is the state of Montana, primarily in the Helena and East Helena area. Applicant is not aware of any instances of actual confusion.

Applicant first became aware of opposer's use and registration of the mark BRAINWORKS through applicant's "August 1, 2000 preliminary search of U.S. Trademark records." (Applicant's answers to opposer's interrogatory Nos. 21 and 22.) When asked if applicant was aware of any use by opposer of the mark BRAINWORKS when applicant adopted

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and/or used its mark in the United States, it answered "No."
(Applicant's answer to opposer's interrogatory No. 3.)

Standing

Opposer's four pleaded registrations have been made of record; and applicant did not contest opposer's standing. We find that opposer has established its standing.

Priority

With regard to the issue of priority in relation to the goods and services set forth in opposer's four pleaded registrations, because opposer owns valid and subsisting registrations of its pleaded mark, the issue of priority does not arise. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995).

Likelihood of Confusion

We turn now to consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In *re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In *re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the

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similarities of the marks and the similarities of the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks."). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We point out that the Board is an administrative tribunal that determines only the right to register marks. See Section 17 of the Trademark Act, 15 U.S.C. §1067. See also, TBMP §102.01 (2d ed. rev. 1, March 2004). As the Court of Appeals for the Federal Circuit stated in the case of *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990):

The issue in an opposition is the right of an applicant to register the mark depicted in the application for the goods [services] identified therein. The authority is legion that the question of the registrability of an applicant's mark must be decided on the basis of the identification of goods [services] set forth in the application regardless of what the record may reveal as to the particular nature of applicant's goods [services], the particular channels of trade or the class of purchasers to which sales of the goods [services] are directed.

Based on the record before us, we find that confusion is likely.

Applicant's mark and opposer's mark are the identical term, BRAINWORKS.¹⁰ This fact "weighs heavily against applicant." In *re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Indeed, the fact that an applicant has selected the identical mark of a registrant "weighs [so] heavily against the applicant that applicant's proposed use of the mark on "goods... [which] are not competitive or intrinsically related [to registrant's goods]...can [still] lead to the assumption that there is a common source." In *re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993). "The greater the similarity in the marks, the lesser the similarity required in the goods or services of the parties to support a finding of likelihood of confusion." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:20.1 (4th ed. 2001).

We turn to a consideration of the du Pont factor regarding the similarity or dissimilarity and nature of the goods and services. As explained above, in Board proceedings, the issue of likelihood of confusion must be determined in light of the goods or services as identified in the involved application and registration(s) and, in the absence of any specific limitations therein, on the

¹⁰ Applicant acknowledges that the marks are "treated as identical" (brief, p. 10), but argues that this fact is not dispositive in this case.

presumption that all normal and usual channels of trade are or may be utilized for such goods or services. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, supra; *Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank*, 811 F.2d 490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Applicant's services are identified as "therapy and rehabilitation services, namely, biofeedback and neurofeedback services." Of the various goods and services identified in opposer's four registrations for the mark BRAINWORKS, we find the most relevant to be opposer's "educational testing and consulting services." While not the same services, the question is whether consumers will believe that the services are sufficiently related such that they come from or are associated with the same source. That is, services (or goods) need not be identical or even competitive to support a finding of likelihood of confusion, it being sufficient instead that the services (or goods) are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); *Chemical New York*

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Corp. v. Conmar Form Systems Inc., 1 USPQ2d 1139 (TTAB 1986); and In re International Telephone and Telegraph Corporation, 197 USPQ 910 (TTAB 1978).

As our primary reviewing Court stated in Recot Inc. v. M.C. Becton, 214 F.3d 1332, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000): "Even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis." The same Court reiterated in the case of Hewlett-Packard Company v. Packard Press, Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) as follows: "Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services."

As identified, opposer's "educational testing and consulting services" could encompass in some manner applicant's "therapy and rehabilitation services, namely, biofeedback and neurofeedback services." In fact, the record shows that "ADD/ADHD and other attentional difficulties" are among the myriad symptoms addressed and conditions treated by applicant; and that opposer's "educational testing and consulting services" involves, inter alia, handling persons with ADD.

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We find that applicant's identified services are related within the meaning of the Trademark Act to at least opposer's identified "educational testing and consulting services."

Turning next to the du Pont factors of trade channels and purchasers, applicant's application does not include any limitation or restriction as to the trade channels for or the purchasers of its services. Therefore, we must presume in this administrative proceeding that the services are offered through all normal channels of trade to all usual classes of purchasers for such services (which would include the general public, e.g., parents and teachers seeking opposer's educational testing or consulting services might also seek applicant's biofeedback and neurofeedback services). See *Octocom Systems Inc. v. Houston Computers Services Inc.*, supra; and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, supra.

We find that the channels of trade and the classes of purchasers for the parties' services, as identified, are similar or at the very least, are overlapping.

Applicant submitted no evidence of third-party uses of the mark BRAINWORKS for goods and/or services in the involved and/or closely related fields.

Neither party is aware of any instances of actual confusion. However, applicant's business is conducted in

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Montana and opposer is located in Texas; there is no evidence of the extent of opposer's sales; and applicant commenced use only in April 2000, and has had minimal sales. Thus, the absence of actual confusion is not surprising. This du Pont factor is neutral. In any event, the test is not actual confusion, but likelihood of confusion. See Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209 (TTAB 1999).

Purchasers aware of opposer's BRAINWORKS educational testing and consulting services, who then encounter applicant's BRAINWORKS therapy and rehabilitation, namely biofeedback and neurofeedback services, are likely to believe that applicant's services emanate from or are licensed or sponsored by opposer.

Decision: The opposition is sustained.